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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/355,990	08/24/1999	TAKAYA NONOMURA	P341-9004	7195

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EXAMINER

DESIR, JEAN WICEL

ART UNIT	PAPER NUMBER
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2614

70

DATE MAILED: 12/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/355,990

Applicant(s)

NONOMURA ET AL.

Examiner

Jean W. Désir

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-9 is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ando (5,109,279) in view of Yamaguchi (5,790,204). (*This is the same rejection as previously presented*).

**Claim 1:**

Ando discloses:

a receiving means for receiving a television broadcast signal, see Fig. 1 items 12, 14;

a first output means for outputting a first video signal based on a video signal contained in a television broadcast received by said receiving means, see Fig. 1 item 18;

a second output means for outputting a second video signal based on an additional information signal contained in the television broadcast signal received by said receiving means, see Fig. 1 item 16;

a second compression means for compressing the second video signal and outputting a second compression video signal, see col. 2 line 27;

and a compositing means for compositing, and outputting onto monitor, a first video signal and the second compression video signal so as to be displayed on different screen portions of said monitor, see Fig. 1 items 36, 38, 40, Fig. 3;

the difference between the claimed invention and Ando's disclosure is that Ando does not explicitly say: the television broadcast signal is digital, the first video signal is compressed by a first compression means. However, receiving digital television broadcast signal is conventional and at level of one skill in the art, and first compression means as claimed is known in the art as evidence see Yamaguchi at Fig. 5 items 113, 123. Ando would have rendered the claimed invention obvious in view of these well known features. An artisan would be motivated to combine the references to arrive at the claimed invention; this combination would effectively assist the viewer when viewing multiple signals on one display. Therefore, the claimed invention would have been obvious to a person of ordinary skill in the art at the time the invention was made.

### ***Response to Arguments***

3. Applicant's arguments, regarding claim 1 have been fully considered but they are not persuasive.

Applicants argue, on page 12 second paragraph of the REMARKS, "that Ando and/or Yamaguchi, taken alone or in combination, fail to disclose or suggest a digital television receiver having at least the element of "a receive means for receiving a digital television broadcast signal. (Emphasis Added)." These arguments are not persuasive, because it was admitted in the Office Action that Ando does not explicitly say that the

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television broadcast signal is digital; however, receiving digital television broadcast signal is conventional and at level of one skill in the art; and artisan would be motivated to modify Ando and/or Yamaguchi for receiving digital signal in order to provide, inter alia, improved quality picture. And, on page 12 last paragraph of the REMARKS, Applicants request the Examiner provide references that teach receiving digital television broadcast signal is conventional in the art. Accordingly, the reference U.S. Patent (5,598,222) to Inventor Lane is cited (see for instance col. 1 lines 15-21), this reference was already provided to the Applicants; and the Applicants also discussed receiving digital television broadcast signal as conventional in the art (see specification page 1 lines 10-17 where PRIOR ART is discussed).

***Allowable Subject Matter***

4. Claims 2-9 are allowed.

**Conclusion**

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jean W. Désir** whose telephone number is **(703) 308-9571**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **John W. Miller**, can be reached at **(703) 305-4795**.

7. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

**(703) 872-9306 (for Technology Center 2600 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

8. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is **(703) 306-0377**.

  
**MICHAEL H. LEE**  
**PRIMARY EXAMINER**

**JWD**

**Dec. 7, 03**